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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,527	06/28/2001	Stephanie Grasso	STEPH01	5137

7590
FRED GRASSO
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08/28/2003

EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 08/28/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,527

Applicant(s)

GRASSO, STEPHANIE

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 July 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. The drawings were received on 7/17/03. These drawings are not approved for entry and have not been entered into the application because they contain new matter, i.e. the exact location, pattern, type of lacing is considered to be new matter.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lacing/threaded support band as claimed in claims 14 and 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yavitz (5600902) in view of Evans (6032386).

Yavitz shows a footwear system comprising an athletic foot covering/sneaker (12) and a planar removable outsole (52, figures 8 and 9) with a rigid plate (62) and a single continuous elastic band (60) for attaching the removable outsole to the sneaker and the

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outsole having traction means (note column 4 lines 9-11) substantially as claimed except for the sole of the sneaker being planar and the exact traction means on the removable outsole. Evans teaches a well known alternative type of sneaker which has a substantially planar sole (24 or 152) and a removable outsole (28 or 160) which has traction means comprising a plurality of cleats (30 or 204). It would have been obvious to use a sneaker with a planar sole as is well known and taught by Evans and to provide a plurality of cleats as the traction means on the removable outsole as taught by Evans in the footwear system of Yavitz to provide a different known style of sneaker and to provide increased traction, different levels of traction, or different types of traction.

Evans clearly teaches many different variations in types of traction means located on the foot covering/sneaker and the removable outsole (column 7 lines 26-32). Evans also teaches the use of additional means for attaching removable outsoles to the sole of a sneaker (see column 6 line 66- column 7 line 15). Evans also suggests the use of different spike designs (see column 7 lines 21-26).

5. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 5, 6, and 8 above, and further in view of Adair (3643352) and Smith (5836090).

Yavitz as modified above shows a system substantially as claimed except for a toe cap and an anchor strap/support band. Smith '090 teaches providing an anchor strap/support band (16 and 16') on a removable outsole. Adair teaches providing a toe cap (shown at 12 in figure 1) in a spiked removable outsole. It would have been obvious to provide a toe cap as taught by Adair and to provide an anchor strap/support

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band as taught by Smith '090 in the system of Yavitz modified above to provide a more secure attachment of the outersole to the foot covering/sneaker.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of McNeil (4525939) and/or Carey (4299037).

Yavitz as modified above shows a system substantially as claimed except for forming the cleats as turf knobs which are part of the outersole. McNeil and/or Carey teaches forming cleats as turf knobs which are formed as part of outersoles. It would have been obvious to form the cleats as turf knobs as taught by McNeil and/or Carey in the system of Yavitz as modified above to reduce the cost and weight of the outersole.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Bauer (4377042), Folk (3009269), or Mastrocola (5615495).

Yavitz as modified above shows a system substantially as claimed except for the bands being tapered. Bauer, Folk, or mastrocola teaches forming bands with tapered walls (32, 22, or 38). It would have been obvious to taper the bands as taught by either Bauer, Folk, or Mastrocola in the system of Yavitz to provide a smoother appearance of the connecting area between the foot covering and the removable outersole.

Yavitz as modified above discloses the claimed invention except for the exact material for the band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use spandex rubber for the band, since it has been held to be within the general skill of a worker in the art to select a known material

on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

8. Claims 7, 10, 13, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 8 above, and further in view of Johnson (4327503).

Yavitz as modified above shows a system and inherent method of using the system substantially as claimed except for the heights of the cleats, i.e. the cleat pattern. Johnson teaches a cleat pattern in which the perimeter cleats (30a-30g) are of greater height than the central cleats (32). It would have been obvious to use a cleat pattern as taught by Johnson in the system and inherent method of using a system of Yavitz as modified above to provide traction means/cleat pattern which is appropriate for both natural surfaces and artificial surfaces.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 8 above, and further in view of Adair (3643352) and either Bauer (4377042), Folk (3009269), or Mastrocola (5615495).

Yavitz as modified above shows a system substantially as claimed except for the bands being tapered. Adair teaches providing a toe cap on a removable outersole. Bauer, Folk, or Mastrocola teaches forming bands with tapered walls (32, 22, or 38). It would have been obvious to provide a toe cap as taught by Adair and to taper the bands as taught by either Bauer, Folk, or Mastrocola in the system of Yavitz to provide a more secure attachment of the outersole, to protect the toe of the footwear and provide

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a smoother appearance of the connecting area between the foot covering and the removable outersole.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 13, 17, and 19 above, and further in view of Smith (5836090).

Yavitz as modified above shows a system and inherent method of use substantially as claimed except for a toe cap and an anchor strap/support band. Smith '090 teaches providing an anchor strap/support band (16 and 16') on a removable outsole. It would have been obvious to provide an anchor strap/support band as taught by Smith '090 in the system of Yavitz modified above to provide a more secure attachment of the outsole to the foot covering/sneaker.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 14 and 15 above, and further in view of Adair (3643352).

Yavitz as modified above shows a system and inherent method of use substantially as claimed except for a toe cap. Adair teaches providing a toe cap (shown at 12 in figure 1) in a spiked removable outsole. It would have been obvious to provide a toe cap as taught by Adair in the system and inherent method of use of Yavitz modified above to provide a more secure attachment of the outsole to the foot covering/sneaker.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 13 above, and further in view of Wilcox (Des 105159).

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Yavitz as modified above shows a system and inherent method of use substantially as claimed except for the exact shape of the cleats. Wilcox teaches forming cleats in the shape of a truncated cone having inwardly bowed sidewalls (see figure 1). It would have been obvious to shape the cleats as taught by Wilcox in the system and inherent method of use of Yavitz to provide a different design, to reduce the weight of the shoe, etc..

Response to Arguments

13. Applicant's arguments filed 7/17/03 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the combination of Yavitz and Evans, the mere reversal of the elements, i.e. the spikes and treaded surface would not defeat the purpose of the system of Yavitz. The system of Yavitz would still function to allow a user to have a spiked footwear when needed and a spikeless footwear for putting. The user would simply put the removable sole on for providing a spiked sole and remove the removable sole when putting and needing a spikeless sole. Evans clearly and explicitly provide the motivation for providing a spikeless permanent sole with spiked removable sole as an alternative to a spikeless removable sole and spiked permanent sole. Also, it is noted that it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

In response to applicants' arguments directed towards the rejection of claim 8, Evans clearly states "it is expressly contemplated that the base section can be spikeless and that various overlying soles can include spikes" in column 7 lines 25-30.

In response to applicants' arguments directed towards the rejection of claims 2 and 9, the fact that the resultant system would be more complicated does not negate the fact that the system may be obvious in view of the prior art and may provide a more secure attachment or have other benefits that may outweigh the extra effort and time needed to use the system.

In response to applicants' arguments directed towards the rejection of claim 14, Smith clearly teaches the use of a support band (16) as claimed.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical

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personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728